

REMARKS

The Office Action of May 29, 2009 has been reviewed and its contents carefully noted. Reconsideration of this case is earnestly requested. Claims 1-4 were cancelled previously. Claims 5-11 are pending in the application.

Rejection Under 35 USC § 112

Claims 5-11 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description and enablement requirements. The Examiner maintains that there is no written description and no enabling disclosure of a "built-in" flexible hose connecting a soft tube with a water tap. Applicant respectfully disagrees with the rejection.

Section 112 of the patent statute describes what must be contained in the patent specification. Among other things, it must contain "a written description of the invention, and of the manner and process of making and using it . . . [such] as to enable any person of ordinary skill in the art to which it pertains . . . to make and use the same" 35 U.S.C. § 112 ¶ 1. Thus, this statutory language mandates satisfaction of two separate and independent requirements: an applicant must both describe the claimed invention adequately and enable its reproduction and use. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to "recount his invention in such detail that his future claims can be determined to be encompassed within his original creation." Id. at 1561, 19 USPQ2d at 1115. Satisfaction of this requirement is measured by the understanding of the ordinarily skilled artisan. Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) ("The description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). "Compliance with the written description requirement is essentially a fact-based inquiry that will 'necessarily vary depending on the nature of the invention claimed.'" Enzo Biochem v. Gen-Probe, Inc., 296 F.3d 1316, 1324, 63 USPQ2d 1609, 1613 (Fed. Cir. 2002). Because of its fact intensive nature, the Federal Circuit reviews a lower tribunal's decision on the

adequacy of written description for clear error. Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000).

The test for compliance with the written description requirement is whether the disclosure as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The standard is whether the written description allows persons of ordinary skill in the art to recognize that the patent applicant invented what is claimed. In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

The test for enablement is whether the disclosure, when originally filed, contained sufficient information regarding the subject matter of the claims as to enable those of ordinary skill in the pertinent art to make and use the invention. The standard is whether the experimentation necessary to practice the invention is undue or unreasonable. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). See also U.S. v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.")

Applicant's independent claim 5 recites a wall-concealed water service box, comprising a **case that has a built-in flexible hose** connecting a soft tube with a water tap and a valve plate. Referring to Figures 1 and 2 of Applicant's specification, the water service box (1) comprises a case (2) having a built-in (*i.e.*, integral) flexible hose (9) connecting a soft tube (34) with a water tap (33) and a valve plate (12). Specification at paragraph [0018], Figs. 1 and 2. The soft tube (34) is a hot or cold water pipe guided from the outside. Specification at paragraph [0032]. It may be verified in the figures that the water service box (1) comprises a case (2) that has a built-in (*i.e.*, integral) flexible hose (9) and a valve plate (12) that opens and closes. Specification at paragraph [0020], Figs. 1 and 2. That is, valve plate (12) is a means to close or open the case (2). Specification at paragraph [0024]. The invention thus provides a unified, wall-concealed water service box, having a built-in flexible hose for connecting soft hot and/or cold water pipes and

the water tap, so as to allow the service box to be opened and closed, without disturbing the pipe connections, thereby unifying, rather than merely housing the connections. Further, with its built-in tubing, the water service box of the invention can be easily assembled and disassembled, and its internal situation can be checked directly by placing a hand through its maintenance hole, so that it will be easy to determine the situation, to retrofit and maintain, and be effective to finish the work neatly with an access plate. Specification at paragraph [0016].

As noted above, Applicant's specification clearly states that the case has a **built-in flexible hose** connecting a soft tube with a water tap and a valve plate. The built-in nature of the flexible hose is clearly described as such at numerous points in Applicant's specification, including, for example, at paragraphs [0007], [0008], [0015], [0016], [0018], [0020], [0046] and [0049]. Therefore, the disclosure reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. Furthermore, the disclosure contains sufficient information regarding the subject matter of the claims to enable those of ordinary skill in the pertinent art to make and use the invention. It is respectfully submitted that the rejections under 35 USC § 112, first paragraph, are thus overcome. Reconsideration and withdrawal of the section 112 rejections are therefore respectfully requested.

Claims 5-11 stand rejected under 35 USC § 112, second paragraph, as being indefinite. The Examiner maintains that there is no written description of a "built-in" flexible hose connecting a soft tube with a water tap. Applicant respectfully disagrees with the rejection.

The requirement that a claim must particularly point out and distinctly claim the metes and bounds of the subject matter that will be protected by the patent grant is an objective one because it is not dependent on the views of any particular individual, but rather is evaluated in the context of whether the claim is definite. The test for claim definiteness is whether the scope of the claim is clear and unambiguous to a hypothetical person possessing the ordinary level of skill in the pertinent art. The claims are to be read in light of the prior art and the specification rather than in a vacuum. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The scope of claim 5 is clear and unambiguous to one of ordinary skill in the art. More particularly, Applicant's specification clearly shows that the case has a **built-in flexible hose**

connecting a soft tube with a water tap and a valve plate. The built-in nature of the flexible hose is clearly described as such at numerous points in Applicant's specification, including, for example, at paragraphs [0007], [0008], [0015], [0016], [0018], [0020], [0046] and [0049]. Therefore, the scope of the claims is clear and unambiguous to a hypothetical person possessing the ordinary level of skill in the pertinent art. It is respectfully submitted that the rejection under 35 USC § 112, second paragraph, is thus overcome. Reconsideration and withdrawal of the indefiniteness rejection are therefore respectfully requested.

It is respectfully submitted that all of the rejections of Applicant's independent claim 5 are thus overcome. Reconsideration and withdrawal of the section 112 rejections of claim 5 are therefore earnestly requested.

Dependent claims 6-11, being dependent upon and further limiting claim 5, should be allowable for the same reason, as well as for the additional limitations recited therein. Reconsideration and withdrawal of the section 112 rejections of claims 5-11 are therefore respectfully requested.

Conclusion

Applicant believes the claims are patentable over the prior art, and that this case is in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicant's attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully submitted,
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